

Remarks

Claims 1-34 were pending in the subject application and were restricted in the Office Action of March 14, 2001. By this Amendment, claims 3 and 11-34 have been canceled. Accordingly, claims 1, 2, and 4-11 are currently before the Examiner and favorable consideration of the pending claims is respectfully requested. The claims have been amended for the purpose of expediting the patent application process in a manner consistent with the Patent and Trademark Office Patent Business Goals (PBG), 65 Fed. Reg. 54603 (September 8, 2000), advancing prosecution, and facilitating the business interests of Applicants. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

✓ Applicants hereby affirm the election of methodology A, claims 1, 2, and 4-10, wherein the metabolic change is the stimulation of lipolysis using foodstuffs supplemented with calcium. Applicants acknowledge the withdrawal of the election of species requirement as applied to claim 6.

The Office Action has rejected claims 1-2 and 4-12 under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for calcium carbonate, does not reasonably convey enablement for other forms of calcium. Particularly, the Office Action states that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicants respectfully traverse.

When rejecting a claim under the enablement requirement of section 112, the Examiner bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with respect to the scope of a claim sought to be patented, the examiner must provide evidence or technical reasoning substantiating those doubts. *Id.*; and MPEP § 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Accordingly, the case law makes clear that properly reasoned and supported statements explaining any failure to comply with section 112 are a

requirement to support a rejection. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

In the case of this rejection, it is respectfully submitted that the Office Action fails to provide evidence or technical reasoning establishing that the specification fails to enable the use of any one of the many known calcium-containing compounds in the claimed methodologies. The Office Action also fails to establish that one skilled in the art would not be aware of, or able to, identify those calcium-containing compounds useful in the practice of the instant invention. Furthermore, it is well-settled law that everything necessary to practice the invention need not be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). For instance, *The Merck Index* is only one of many sources that may be used to provide a listing of calcium-containing compounds suitable for use as food additives (e.g., calcium chloride, calcium citrate, calcium iodate, calcium iodide, calcium iodobenate, calcium iodostearate, calcium lactate, calcium levulinate, calcium mesoxalate, calcium phosphate, calcium propionate, calcium stearate, calcium tartrate, and calcium sulfate). A copy of those pages listing calcium-containing compounds, taken from *The Merck Index*, is included for the Examiner's convenience. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

check  
declaration  
OK  
withdrawn  
Claims 1-2 and 4-10 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Carper. Applicants respectfully traverse. In view of the attached declarations, it is respectfully submitted that Carper is not prior art to the invention and that the publication disclosure was derived from one of the inventors during the course of an interview. Alternatively, the invention was conceived and reduced to practice before the publication date of the reference in question. Accordingly, withdrawal of the rejection is respectfully requested.

declaration  
OK  
withdrawn  
Claims 1-2 and 4-10 have been rejected under 35 U.S.C. § 102(a) or (b) as being anticipated by Zemel et al. (AP). The Office Action has also requested that Applicants supply the publication dates of a variety of references, including this reference. Applicants were unsuccessful in obtaining a publication date for the above-identified reference (Reference AP) in the local scientific library collection of *The FASEB Journal* and sought to obtain the publication date of the reference from the publisher of the reference. As indicated in the attached letter from the Senior Annual Publications Editor, the abstract forming the basis of this rejection was not published or distributed by *The FASEB Journal*. The publication date attributed to the publication in the IDS was the result of

miscommunication between the undersigned and the inventors. Accordingly, this reference is not prior art to the subject application and withdrawal of the rejection is respectfully requested.

With respect to the additional publication dates sought by the Examiner in this matter, Applicants provide the following information and publication dates. Copies of the journal covers are attached hereto.

Reference	Authors	Date Received by Library
AK	SHI <i>et al.</i> [2000] FASEB J. 14:555.3 (page A790)	March 21, 2000
AL	SHI <i>et al.</i> [2000] Obesity Research 8(1):52S	October 25, 2000
AR	ZEMEL <i>et al.</i> [2000] Obesity Research 8(1):118	February 9, 2000

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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- Attachments: (1) *The Merck Index*, 1996, pages 270-8, 12<sup>th</sup> Ed., Published by Merck Research Laboratories, Division of Merck & Co., Inc., U.S.
- (2) Declaration of Dr. Michael B. Zemel
- (3) Declaration Under 37 C.F.R. § 1.131, executed by M. Zemel & H. Shi, with attachment
- (4) Declaration Under 37 C.F.R. § 1.131, executed by P. Zemel, with attachment
- (5) July 3, 2001 letter from R. Grunspan of *The FASEB Journal*
- (6) Three Journal Covers (see table, *supra*)
- (7) Second Supplemental IDS with PTO/SB/08B, 14 references, and 1 videotape
- (8) Fee Transmittal Form (in duplicate)
- (9) Transmittal Form